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09/750,144

12/29/2000

Steve Lewontin

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6775

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7590

04/18/2008

ALSTON & BIRD LLP

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101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

EXAMINER

DESAI, RACHNA SINGH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE LEWONTIN

Appeal 2007-4183
Application 09/750,144
Technology Center 2100

Decided: April 18, 2008

Before ALLEN R. MACDONALD, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

Prior Art

Among the prior art relied upon by the Examiner in rejecting the claims on appeal is:

Amano	US 6,003,033	Dec. 14, 1999
Call	US 2002/0143521A1	Oct. 3, 2002
Simon Hunt	US 2004/0049737A1	Mar. 11, 2004

Rejections

The Examiner rejected claims 1-3, 5, 7, 10-13, 15, 17, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simon Hunt and Amano.

The Examiner rejected claims 4, 6, 8, 9, 14, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simon Hunt, Amano, and Call.

Appellant's Contentions

Appellant contends that the Examiner erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) because the Simon Hunt reference is not prior art to the claimed invention (App. Br. 4-8).

Result

We reverse.

ISSUE

Has Appellant established that the Examiner erred in rejecting claims 1-21 as being unpatentable under 35 U.S.C. § 103(a).

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellant Application

1. Appellant's patent application was filed on December 29, 2000.

Simon Hunt

2. The Simon Hunt patent application was filed on October 25, 2002.
3. The Simon Hunt patent application publication claims priority under 35 U.S.C. § 120 to non-provisional U.S. patent applications 09/842,474 and 09/843,036 both filed on April 25, 2001.
4. The Simon Hunt patent application publication also claims priority under 35 U.S.C. § 119(e) to U.S. provisional application 60/199,858 filed on April 26, 2000.
5. The Simon Hunt patent application named as inventors Wallace, Wiatrak, Matlin, Hayosh, McHugh, and Simon Hunt.
6. U.S. provisional application 60/199,858 named as inventors Trapani and Polonsky.
7. The Simon Hunt patent application does not share an inventor with U.S. provisional application 60/199,858.

PRINCIPLES OF LAW

35 U.S.C. § 119(e)(1) Benefit of earlier filing date; right of priority.

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title,

by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

35 U.S.C 119(e)(1) (emphasis added).

ANALYSIS

Appellant correctly argues that the Simon Hunt reference is not prior art to the claimed invention (App. Br. 4-8).

The filing dates of the Simon Hunt publication and the 09/842,474 and 09/843,036 U.S. patent applications to which Simon Hunt claims priority are all later than the filing date of Appellant's patent application. (FF 1-3). To qualify as prior art the Simon Hunt publication must be able to legally claim priority to U.S. provisional application 60/199,858 which was filed before Appellant's patent application. (FF 4).

However, the Simon Hunt patent application cannot claim priority to U.S. provisional application 60/199,858, because none of the inventors named on the Simon Hunt patent application are named on U.S. provisional application 60/199,858 as required by 35 U.S.C. § 119(e)(1). (FF 5-7). Thus the Simon Hunt patent application cannot be used as a basis for the rejections indicated above.

CONCLUSIONS OF LAW

(1) It has been established that the Examiner erred in rejecting claims 1-21 as being unpatentable under 35 U.S.C. § 103(a).

(2) On this record, claims 1-21 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-21 is reversed.

REVERSED

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